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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,054	10/03/2000	Albrecht Dorschner	Beiersdorf 656-KGB	4744

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NORRIS, MCLAUGHLIN & MARCUS, P.A.
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EXAMINER

LAMM, MARINA

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 08/22/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Supplemental
Office Action Summary

Application N .

09/679,054

Applicant(s)

DORSCHNER ET AL.

Examiner

Marina Lamm

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 5,7-13 and 16-19 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 5,7-13 and 16-19 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claims pending are 5, 7-13 and 16-19.

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 7, 8 and 16-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 16-19 are viewed as indefinite because they depend from the cancelled Claim 1. Thus, the scope of the claimed invention is unascertainable because it is unclear what additional limitations are incorporated into Claims 7 and 16-19.

Double Patenting

3. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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4. Claims 5, 7-13 and 16-19 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 5-18 of copending Application No. 10/365,847. An obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but an examined application claim is not patentably distinct from the reference claim(s) because the examined claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985). Although the conflicting claims are not identical, they are not patentably distinct from each other. Claims 5, 7-13 and 16-19 of the instant invention and Claims 5-18 of the copending application are directed to an o/w microemulsion comprising at least one emulsifier A, optionally substances that are soluble or dispersible in the oil phase or the water phase and an effective amount of one or more insect repellents. The optional oil-soluble or dispersible substances (component (b)) and insect repellents (component (c)) the instant claims are the same compounds as those claimed in the claims of the copending application. The only difference between the conflicting claims is that Claim 5 of the copending application recite additional emulsifiers that can be used as emulsifier A (component (a)). The portion of the specification in SN 10/365,847 that supports the recited emulsifiers A, includes the emulsifiers that would anticipate Claim 5 herein. Claims 5, 7-13 and 16-19 cannot be considered patentably distinct over Claims 5-18 of the copending application when there is a specifically disclosed embodiment in the copending application that supports Claim 5 of that application and falls within the scope of Claim 5 herein because it would have been obvious to one having

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ordinary skill in the art to modify the composition of Claim 5 of the copending application by selecting a specifically disclosed embodiment that supports that claim, i.e., the specific emulsifiers A disclosed in the copending application. One having ordinary skill in the art would have been motivated to do this because that embodiment is disclosed as being a preferred embodiment.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 5 and 7-13 are rejected under 35 U.S.C. 102(b) as being anticipated by Thomas et al. (US 5,610,130).

Thomas et al. teach oil-in-water microemulsions containing 0.1-20% of ethoxylated glycerol-based non-ionic surfactants, 0-5% of fatty acids such as stearic acid, and 0.5-20% of insect repellents such as DEET (N,N-diethyl-m-toluamide). See Abstract; col. 4, lines 1-7; col. 5, lines 33-34. The stearic acid of Thomas et al. is an emulsifier A of the instant claims. With respect to Claims 12 and 13, the microemulsions of Thomas et al. may contain anionic surfactants. See col. 6, lines 61-67; col. 7-8.

Thus, Thomas et al. teach each and every limitation of Claims 5 and 7-13.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 16 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Moore et al. (US 6,063,746).

Thomas et al. applied as above. The reference does not teach the emulsifiers of the instant claims. However, the claimed emulsifiers are well known in the emulsion art and are conventionally used for the same art-recognized purpose as the emulsifiers of Thomas et al., i.e. for the formation and stabilization of oil-in-water emulsions. Thus, Moore et al. teach employing cetareth-12 and cetareth-20 "to enable an emulsion to be formed when the oil and water phases are mixed". See col. 3, lines 49-52. Therefore, it would have been obvious to one having ordinary skill in the art at the time the claimed invention was made to use cetareth-12 and/or cetareth-20 of Moore et al. for emulsions of Thomas et al. with a reasonable expectation of obtaining a stable oil-in-water microemulsion having the same or similar properties as set forth in the Thomas et al. reference. The selection of a known material based on its suitability for its intended use is obvious absent a clear showing of unexpected results attributable to the applicant's specific selection. See e.g., *In re Leshin*, 227 F.2d 197, 125 USPQ 416 (CCPA 1960).

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9. Claims 18 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Thomas et al. in view of Klier et al. (US 4,127,672).

Thomas et al. applied as above. While teaching DEET, the reference does not teach the insect repellents of the instant claims. However, Klier et al. teach that insect repellents such as DEET, when applied to a plastic object, can damage plastic by partially dissolving or swelling it. See col. 1, lines 26-37. Klier et al. teach improved repellents such as 3-(N-n-butyl-N-acetyl) aminopropionic ethyl ester, which “do not attack or damage plastic objects even after prolonged contact time.” See col. 1, lines 42-47; col. 2, lines 29-37. The improved propellants of Klier et al. are suitable for using in cleaning compositions. See col. 6, lines 67-68; col. 7, lines 1-2. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the cleaning compositions of Thomas et al. such that to employ 3-(N-n-butyl-N-acetyl) aminopropionic ethyl ester instead of DEET as an insect repellent. One having ordinary skill in the art would have been motivated to do this to obtain insect repellent cleaning compositions which can be used to clean plastic objects without damaging the plastic even after prolonged contact time as suggested by Klier et al.

Response to Arguments

10. Applicant's arguments filed 2/11/03 have been fully considered but they are not persuasive.

11. The Applicant's arguments over the Thomas et al. and Neumiller reference have been addressed previously. See Office Action mailed 11/15/02 (paper #16). Additionally, the Applicant argues that Claim 5 as amended “is not rendered obvious when the additional limitations with regard to the amount and specific type of emulsifier is considered.” In

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response, it is noted that Thomas et al. explicitly teach the amount and type of emulsifier as claimed in the amended Claim 5. More specifically, Thomas et al. teach 0-5% of fatty acids such as stearic acid. See above.

Conclusion

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 5,569,411 – discloses cleaning compositions, which may be in the form of o/w microemulsions, containing insect repellents and non-ionic emulsifiers; US 6,255,253 and WO 99/08517– both disclose o/w microemulsions containing 10-40% of insect repellents and 10-30% of non-ionic emulsifier such as alkyl(oligo)glycoside.

13. No claim is allowed at this time.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marina Lamm whose telephone number is (703) 306-4541.

The examiner can normally be reached on Monday to Friday from 9 to 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached at (703) 308-2927.

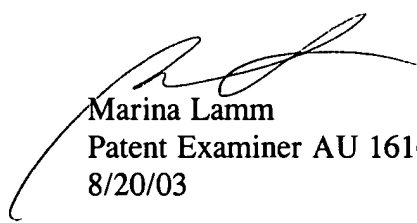
The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

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Marina Lamm
Patent Examiner AU 1616
8/20/03